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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,702	10/30/2001	Steven Wang	INTL-0679-US (P12997)	9571
21906	7590	05/26/2006	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			TAYLOR, NICHOLAS R	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/020,702

Applicant(s)

WANG, STEVEN

Examiner

Nicholas R. Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-30 have been presented for examination and are rejected.

### ***Response to Arguments***

2. Applicant's arguments filed March 6th, 2006, with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

3. The use of the trademark Bluetooth™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 11 uses the language, "An article comprising a medium storing instructions." The specification is silent regarding the

composition of the “medium.” Therefore, the plain language interpretation of the claim is limited to the statutory interpretation that includes “signals” which cannot store.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6, 7, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph.

The claim contains the trademark/trade name Bluetooth™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to describe the characteristics of a wireless connection and, accordingly, the description is indefinite.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 9-15, 19-27, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodenmann et al. (U.S. Patent 6,078,789).

10. As per claims 1, 11, and 21, Bodenmann teaches a method comprising:  
establishing a wireless link between a cableless provider and a consumer; and  
(Bodenmann, col. 4, lines 4-18)

storing information exchanged to establish said link; and using said stored  
information to reestablish said link (Bodenmann, col. 10, line 61 to col. 11, line 12).

11. As per claims 2, 12, and 22, Bodenmann teaches the system further including  
exchanging information upon the first connection between a given cableless provider  
and a consumer. (Bodenmann, col. 10, line 61 to col. 11, line 12).

12. As per claims 3 and 13, Bodenmann teaches the system further including storing  
information in order to avoid the need to exchange information each time a connection  
is established (Bodenmann, col. 10, line 61 to col. 11, line 12, wherein the full PnP ID is  
stored for future reference).

13. As per claims 4 and 14, Bodenmann teaches the system further including  
denominating said consumer as the master device and said cableless provider as slave

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device (Bodenmann, col. 6, lines 47-65, and fig. 4, where the FRAMETYPE field denotes the Master in the device relationship).

14. As per claims 5, 15, and 30, Bodenmann teaches the system further including programming said consumer to always be the master device (Bodenmann, col. 6, lines 47-65, and fig. 4, see the FRAMETYPE field options).

15. As per claims 9, 19, and 27, Bodenmann teaches the system further including providing an indication bit that identifies the cableless provider to establish a connection (Bodenmann, col. 10, line 61 to col. 11, line 12; see also the SHORT\_ID of col. 8, lines 32-65).

16. As per claims 10, 20, and 29, Bodenmann teaches the system further including providing information to a consumer from a cableless provider that indicates the type of device of the cableless provider (Bodenmann, col. 10, line 61 to col. 11, line 12; see also the SHORT\_ID of col. 8, lines 32-65).

17. As per claim 23, Bodenmann teaches the system further wherein said device is a consumer (Bodenmann, col. 4, lines 4-18).

18. As per claim 24, Bodenmann teaches the system further wherein said device operates at 2.4 gigahertz at a range of approximately ten meters (Bodenmann, wherein

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the device operates at any frequency, at col. 6, lines 9-13, and operates at ranges under 20 meters, at col. 2, lines 34-36).

19. As per claim 25, Bodenmann teaches the system further wherein said device does not provide for authentication (Bodenmann, col. 6, lines 20-46, wherein no authentication takes place).

20. As per claim 26, Law-Cannon teaches the system further wherein said device does not provide for pairing (Bodenmann, col. 6, lines 20-46, wherein no pairing takes place).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 6-8, 16-18, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodenmann et al. (U.S. Patent 6,078,789) and Law et al. (U.S. PGPub 2001/0056501).

23. As per claims 6 and 16, Bodenmann teaches the above, yet fails to specifically teach enabling a Bluetooth™ connection.

Law teaches the use of the Bluetooth™ protocol in wireless consumer and provider setting (Law, paragraph 0030; see also paragraphs 0010-0012) where the device is identified through FHS packets (paragraph 0031-0032, wherein FHS packets are an essential part of the Bluetooth™ protocol).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Bodenmann and Law to provide the Bluetooth™ functionality of Law in the system of Bodenmann, because doing so would enable wireless connections that remain active for extended periods of time using limited energy sources while at the same time providing improved network connection establishment response times (Law, paragraph 0026).

24. As per claims 7 and 17, Bodenmann-Law teaches the system further including enabling a Bluetooth™ connection between said consumer and said cableless provider without providing for authentication (Law, paragraph 0031-0032, where no authentication takes place).

25. As per claims 8 and 18, Bodenmann-Law teaches the system further including enabling a connection between the cableless provider and the consumer without providing for pairing (Law, paragraph 0031-0032, where no pairing takes place).

26. As per claim 28, Bodenmann teaches the above, yet fails to teach wherein said device identifies itself through an FHS packet.



Law teaches the use of the Bluetooth™ protocol in wireless consumer and provider setting (Law, paragraph 0030; see also paragraphs 0010-0012) where the device is identified through FHS packets (paragraph 0031-0032, wherein FHS packets are an essential part of the Bluetooth™ protocol).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Bodenmann and Law to provide the Bluetooth™ functionality of Law in the system of Bodenmann, because doing so would enable wireless connections that remain active for extended periods of time using limited energy sources while at the same time providing improved network connection establishment response times (Law, paragraph 0026).

### ***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:00am to 5:30pm, with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas Taylor  
Examiner  
Art Unit 2141

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER